

RESPONSE UNDER 37 C.F.R. § 1.116  
Appl. No. 10/517,895

Atty. Docket No. Q85487

## **REMARKS**

### **I. Response to Double Patenting Rejection**

Claims 1 and 3-5 remain provisionally rejected under the judicially created doctrine of obviousness-type double patenting as allegedly being unpatentable over claim 1 of co-pending application No. 10/507,895.

Applicants defer responding to the provisional obviousness-type double patenting rejection.

### **II. Response to Claim Rejections under 35 U.S.C. § 103**

Claims 1-3, 6-8 and 10-18 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Hirai et al.

Applicants respectfully traverse the rejection.

Claims 1 and 8 recite that the photocatalyst has a capsule structure comprising a cadmium compound shell and a void.

The Examiner admits that Hirai et al does not disclose that the particles exhibit a "cadmium compound shell and a void", as required by present claims 1 and 8. See Office Action dated May 26, 2006, page 5, lines 14-15.

The Examiner's position is that Hirai et al teaches methods for producing particles comparable to those of the present invention and that one of ordinary skill would reasonably expect that the particles produced by the process of Hirai et al would also have a shell and void.

However, as pointed out in the Amendment filed on March 7, 2006, a non-aqueous dispersion of the metal (compound) particles is obtained from the process described in Hirai et

al and not a capsule structure as required by the present claims. Therefore Examiner has not pointed to a specific teaching or suggestion that would lead one of ordinary skill to modify the disclosure of Hirai et al (to arrive at the invention of claims 1 and 8) with a reasonable expectation of success.

Further, the subject matter of the present invention is "a particle having a specific structure, and a method for producing the same". On the other hand, the subject matter of Hirai et al is "a method for preparing a non-aqueous dispersion of particles", which is different from that of the present invention as discussed above. Thus, for this additional reason the Examiner has not set forth a reasonable basis for asserting that the particles of Hirai et al would *inherently* have a shell and a void.

Accordingly, Applicants submit that Hirai et al does not render the present invention obvious, and withdrawal of the foregoing rejection is respectfully requested.

(2) Claims 1-8, 12 and 19-23 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Bühler et al.

Applicants respectfully traverse the rejection.

Claims 1 and 8 recite that the photocatalyst has a capsule structure comprising a cadmium compound shell and a void.

Bühler et al discloses a catalyst comprising a cadmium sulfide/semiconductor powder, which is at least partially coated with a noble metal, e.g., platinum. However Bühler et al fails to disclose, teach or otherwise suggest a capsular structure comprising a cadmium compound shell and a void as claimed. Moreover, the Examiner has to pointed to any teaching in the art which would motivate one of ordinary skill to modify the disclosure so as to achieve the claimed

capsular structure with a reasonable expectation of success. Thus, the present invention is not rendered obvious by Bühler et al.

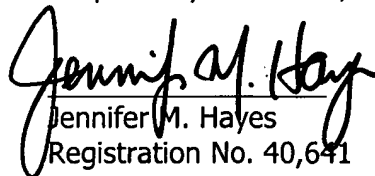
Accordingly, Applicants respectfully request withdrawal of the rejection.

### **III. Conclusion**

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

  
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